

Notice of Allowability

Application No.

10/671,326

Examiner

Nyeemah Grazier

Applicant(s)

WANG ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/22/05.
2. ☒ The allowed claim(s) is/are 1, 5, 9-13, 18-22, 24, 27, 30-32, 39, 43, 45-47 and 49.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 9/29/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

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DETAILED ACTION
NOTICE OF ALLOWANCE

I. ACTION SUMMARY

The Amendments to the Claims and Remarks submitted to the Office by facsimile on November 22, 2005 has been fully considered and will be the basis of the following Notice of Allowance.

Claims 1, 5, 9-13, 18-22, 24, 27, 30-31, 43, 45-47 and 49 are currently pending. Claims 1, 30 and 39 have been amended. Claims 2-4, 6-8, 14-17, 23, 25-26, 33-38, 40-42, 44 and 48 are cancelled. Claims 32 and 39 have been rejoined.

II. INFORMATION DISCLOSURE STATEMENT

The supplemental information disclosure statements filed on September 29, 2005 and November 22, 2005 have been fully considered by the Examiner.

III. RESPONSE TO AMENDMENTS

A. Priority

Applicant was invited to show the requisite support in the original disclosure of provisional applications 60/414,207 filed on September 26, 2002 and 60/448,216 filed on February 19, 2003 because it appeared that all the limitations of instant claim 1 was not supported in the provisional application. Applicant's arguments, see Remarks filed September 29, 2005, p. 64, with respect to Priority have been fully considered and are persuasive. The comment/objection with regard to priority has been withdrawn.

B. Election: Response to Election (Remarks September 29, 2005)

Applicant's telephonic election with traverse of Group I, claims 1-31 and specie election of compound 149 in Table 2 on page 170 of the Specification, with traverse on June 16, 2005 has been acknowledged by the Applicant in the Response. The traversal is on the ground(s) that a search of the claims in its entirety would not be unduly burdensome. This is not found persuasive because of the rationale given in the Action filed on June 29, 2005. (See Section III. Restriction, pp. 7-8). Because inventions I-III are distinct for the reasons given in the previous Action and the search required for Group I is not required for Group II or III, restriction for examination purposes as indicated is proper. Invention I-III is unrelated and a different subject matter than Invention IV as stated in the previous action. Because these inventions are distinct for the reasons given and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. The requirement is still deemed proper and is therefore made FINAL.

Rejoinder: It should be noted that the process claims may be rejoined. (See Advisory of Rejoinder, previous Action). Applicant arguments in Remarks filed on November 22, 2005 have been considered and are persuasive. Process of using claims, claims 32 and 39 have been rejoined. Applicant's process of making claim, claim 40 does not recite steps and have been cancelled by the Applicant. Applicant reserves the right to file divisional applications on the non-elected subject matter.

C. Status of the Claims

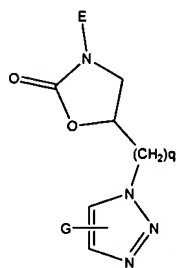
i. Extended Prior Art Search M.P.E.P. §803.02

If upon examination of the elected species, no prior art is found that would anticipate or render obvious the instant invention based on the elected species, the search of the Markush-type claim will be extended. See M.P.E.P. § 803.02 (2001). If prior art is then found that anticipates or renders obvious the non-elected species, the Markush-type claim will be rejected. It should be noted that the prior art search will not be extended unnecessarily to cover all non-elected species. Should Applicant overcome the rejection by amending the claim, the amended claim will be reexamined. Id. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. Id. In the event prior art is found during reexamination that renders obvious or anticipates the amended Markush-type claim, the claim will be rejected and the action made final. Id.

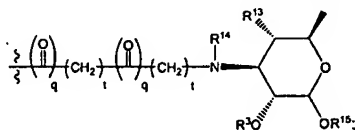
As indicated in the original Action filed on June 29, 2005, Examiner searched the compound based on the elected species, Compound 149 in response to the requirement to restrict the products of Formula in Claim 1. However, there was no prior art of record that anticipated or rendered obvious the elected species and therefore the scope of the subject matter was **extended or broaden** in pursuant to M.P.E.P. § 803.02.

The prior art search was extended to include the formula:

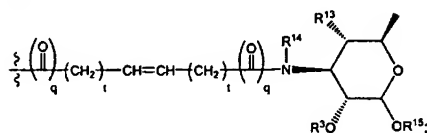
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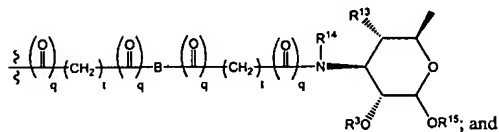
Wherein:

G is selected from the group consisting of:

9a)



9b)



E, q and the other variables are recited in Amendments to the Claims, filed on November 22, 2005. (See Remarks, filed November 22, 2005, p. 52).

D. 35 USC §102 Rejection

Applicant's arguments, see Remarks, filed November 29, 2005, with respect to 102 Rejection have been fully considered and are persuasive because in light of the amendment, whereby G is no longer C1-8 acyl, the issue is moot. The 102 rejection of claims 1, 2, 4, 5, 9, 10, 11, 12, and 13 has been withdrawn.

E. 35 U.S.C. 112, 2nd Rejection

Applicant's arguments, see Remarks, filed November 29, 2005, with respect to 112, 2nd Rejection have been fully considered and are persuasive because Applicant has obviated the rejection by (1) canceling claim 29 and (2) by inserting the structures into the claim instead of referring to the Specification and (3) amending claim 13 by replacing "t" with "x". Thus, the 112, 2nd rejections of claims 13, 29 and 30 have been withdrawn.

F. Objection to the Specification

Applicant's arguments, see Remarks, filed November 29, 2005, with respect to objection to the Abstract has been fully considered and are persuasive. In light of the amended Abstract, the objection is withdrawn.

IV. EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Heidi A. Erlacher, Esquire on November 30, 2005.

The application has been amended as follows:

1. Delete "4" and insert ---1--- in claim 5, p. 13 of 53;
2. Delete "26" and Insert ---1--- in claim 27, line 3, p. 20 of 53;

V. REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance: The instant invention is drawn to antibacterial agents. The instant invention appears to be free of the art of record. The closest prior art reference of record is Phillips, et al. "Synthesis and antibacterial activity of 5-substituted oxazolidinones," *Bioorganic and Medicinal Chemistry* (2003), vol. 11, pp. 35-41.

Phillips, et al. teaches a series of 5-substituted oxazolidinones and there uses as antibacterial agents. The Phillips, et al. reference does not anticipate or render obvious the instant invention because the instant invention as variable G as a substitution on the triazole ring that is not present in the prior art reference.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

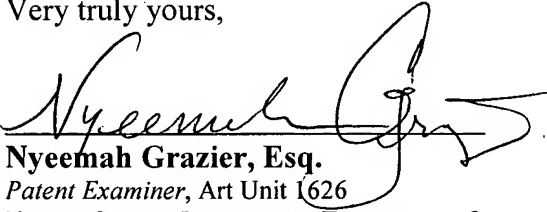
VI. CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:30 a.m. - 6:00 p.m.

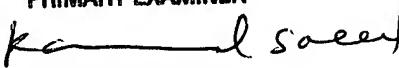
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Very truly yours,


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